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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,578	02/23/2004	Kevin C. Farrell	CM06657LL	4367
24273	7590 12/21/2005		EXAMINER	
MOTOROLA, INC			JOHNSON, JONATHAN J	
INTELLECTUAL PROPERTY SECTION LAW DEPT			ART UNIT	PAPER NUMBER
8000 WEST SUNRISE BLVD			1725	
FT LAUDERDAL, FL 33322			DATE MAILED: 12/21/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
•	10/786,578	FARRELL ET AL.				
Office Action Summary	Examiner	Art Unit				
	Jonathan Johnson	1725				
 The MAILING DATE of this communication app Period for Reply 	ears on the cover sheet with the c	orrespondence address				
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period was preply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be timulated the second will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) filed on 17 O	<u>ctober 2005</u> .					
2a)⊠ This action is FINAL . 2b)□ This	This action is FINAL . 2b) This action is non-final.					
·— · · ·	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11, 45	i3 O.G. 213.				
Disposition of Claims						
4)⊠ Claim(s) <u>1 and 4-7</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdraw	4a) Of the above claim(s) is/are withdrawn from consideration.					
5) Claim(s) is/are allowed.						
6)⊠ Claim(s) <u>1,4-7</u> is/are rejected.						
7) Claim(s) is/are objected to.	1.0					
8) Claim(s) are subject to restriction and/o	r election requirement.					
Application Papers						
9) The specification is objected to by the Examine	r.					
10)☐ The drawing(s) filed on is/are: a)☐ acc	epted or b) \square objected to by the I	Examiner.				
Applicant may not request that any objection to the						
Replacement drawing sheet(s) including the correct						
11)☐ The oath or declaration is objected to by the Ex	taminer. Note the attached Office	Action or form P10-152.				
Priority under 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a) ☐ All b) ☐ Some * c) ☐ None of:						
1. Certified copies of the priority documents have been received.						
 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage 						
 Copies of the certified copies of the prior application from the International Bureau 	·	ed in this National Stage				
* See the attached detailed Office action for a list		ed.				
300 110 211251102 23121102 211101 21101 101 21101						
Attachmont(c)						
Attachment(s) 1) Notice of References Cited (PTO-892)	4) Interview Summary	(PTO-413)				
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail D	ate				
Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	6) Other:	Patent Application (PTO-152)				

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,207,475 (Lin). Lin teaches a solderable substrate having an adhesive material applied to a portion of the solid solder element so as to overlap with the solderable substrate outside of a predefined area reserved for subsequent component placement (fig. 5f, items 48 and 84), the adhesive material immobilizing the solid solder element during reflow (col. 10, l. 12-32); the adhesive material overlapping the solderable substrate and the solid solder element, the adhesive material cured so as to immobilize the solid solder element; and the component subsequently being coupled to the solderable substrate via the solid solder element during a reflow process (col. 10, ll. 10-65); wherein the component is at least one of mechanical, electrical, and electromechanical components (abstract); wherein the adhesive material is characterized by a predetermined application viscosity, predetermined volume reduction during the reflow process, retention of adhesive qualities during the reflow process, and an inability to mix with the solid solder element during the reflow process (col. 10, ll. 10-65).

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Response to Arguments

Applicant argues the teachings of Lin does not perform the same function as applicant's invention. The examiner agrees. Applicant goes on to argue that Lin does not anticipate the claims. The examiner disagrees. The examiner understands that, as with any other claim limitation, functional language is acceptable so long as it sets definite boundaries on the patent protection sought. In re Barr, 170 USPQ 33 (CCPA 1971). If the prior art structure is capable of performing the intended use, then it meets the claim. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). In addition, "expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). To put it another way: While the features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In the instant case, as stated in the previous office action, it is the examiner's position that the adhesive material and the interface apparatus of Lin is capable of performing in the claimed manner. Applicant has neither argued or provided any extrinsic evidence showing that adhesive material and the interface apparatus of Lin cannot performed in the claimed manner. The rejection is maintained despite applicant's traversal.

Conclusion

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Johnson whose telephone number is 571-272-1177. The examiner can normally be reached on M-Th 7:30 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jonathan Johnson Primary Examiner Art Unit 1725

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